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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT PAPER NUMBER

1756

DATE MAILED: 05/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,327

Applicant(s)

NAKAMURA ET AL.

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/617,748.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

- ✓ Claim 14 is objected to because of the following informalities: "an polyester" should be "a polyester" in line 1 of claim 14. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- ✓ Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It appears that claim 12 is claiming a single means (i.e., a developing mechanism: note section 112, second paragraph rejection of this claim below). A single means is subject to an undue breadth rejection per *In re Hyatt*, 218 USPQ 195, because the specification discloses only those means known to the inventor yet the claim covers every conceivable means for performing the stated function. See MPEP 2164.08(a).

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Claims 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claim 21 states that the alcohol component contains more than 90 mole % of the bisphenol-A-alkylene oxide additive. The specification as filed fails to disclose this range of percentages for this component. Specification page 15, lines 9-13 states that this component can be used in an amount of 80 mole % or more, preferably 90 mole % or 95 mole %. This does not provide basis to exclude 90 mole % but to include all other percentages above 90 mole %. There appears to be no other basis for the current claim language in the specification.

New claim 22 specifies a collecting step using a "high efficiency particulate air" filter. The Examiner was unable to find basis for this limitation in the specification. HEPA filters are disclosed (p. 11, l. 7-16), but there is no apparent description of this abbreviation meaning the same as the claim language. If basis is present applicants are asked to refer the Examiner to the appropriate page and line.

Claims 12, 13, 16, 17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ Claim 12 is indefinite because it is unclear what the developing mechanism is. It is unclear if this is a single means or a combination of means that perform the recited function.

✓ Claim 13 is indefinite because there is no antecedent basis for "the component having a molecular weight of 500 or less". The claim is also indefinite because the "ratio" of the component

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is defined as an amount in parts by weight. A ratio is a comparison of two values not an amount. Clarification of the claim is suggested.

✓ Claim 16 is indefinite because "n" is undefined. See original claim 5 for a suitable definition to add to claim 16.

✓ Claim 17 is indefinite because it is unclear if the polypropylene's molecular weight is based on number-average, weight-average, viscosity-average, or some other basis. The same polymer can and usually does have different molecular weights when measured for different bases.

✓ Claim 19 is indefinite because there is no antecedent basis for "said 500 to 1000 weight component".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Hirao *et al.* in US Patent 6,175,715.

Hirao discloses an image forming apparatus that contains an image forming unit as an exposure LED **216** with chargers **215** that form an electrostatic image on the photosensitive drum **211**. The electrostatic image is developed by developing unit **219** and fixed at fixing station **410** by flash fusing light **412**. Near the fusing station is a blower **8** that collect smoke, odor, and high molecular weight organic substances in filter **82**. See column 14, line 36, through column 17, line 8.

Applicants are advised that the toner does not provide a patentable limitation to the apparatus because an apparatus is defined by its structure not the materials acted upon by the apparatus. Because the toner is consumed in the development process it is seen as the material worked upon by the apparatus. "A recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed." *Ex parte Masham* (BdPatApp&Int) 2 USPQ2d 1647.

✓ Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Ohno *et al.* in US Patent 5,840,459 or EP 901 046.

Ohno discloses in Figure 13 a developing apparatus having a developing mechanism **301** containing a developing sleeve **306** that transports toner **313**. The toner contains a polyester binder resin and a colorant as seen in Examples 4-6, which produce toners IV-VI (see Tables 2 and 3, cols. 37-38). The polyesters contain between 6.2 and 6.5 % of a resin component having a molecular weight of less than 1000.

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The EP '046 EP document exemplifies a developing apparatus (Fig. 2) that contains a toner comprising a binder resin and a carbon black colorant in Example 1 (pp. 27-28). The toner is mixed with 50  $\mu$ m diameter toner to form a two-component developer. Analysis of the toner shows a THF soluble component from the resin having molecular weights of 1000 or less in an amount of 1.0% based on the weight of the toner. Note the other toners having low levels of components with a molecular weight of 1000 or less in Tables 1, 8 and 15 (pp. 30, 41, 56, and 57). The toner develops the image formed on a photoreceptor drum by developing mechanisms 4 (pp. 21-23). Also note the structure in Figure 8.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 13, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7-244400 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162, and further in view of *Electrophotography* to Schaffert, pp. 55-57.

The Japanese document, as seen in the Abstract, discloses a color toner a colorant a vinyl resin. The toner has less than 3 weight percent of components with a molecular weight less than or equal to 1000. The toner is excellent in fixing characteristics such as image density and fog and does not cause toner scattering. The Japanese document does not disclose the specific process steps for using the toner in the Abstract.

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Diamond discusses the conventional process steps of using a toner to form a visible image. These steps include charging, exposure, development, transfer, fusing, and cleaning (p. 160). Fusing is specifically discussed on page 161 as being conventionally conducted by fusing with a radiant heat from a lamp (i.e., flash fusing).

Schaffert discloses fixing of toner particles through the use of a high intensity flash fusing process (p. 56). The text discusses research in the area of flash fusing. One method in the art is known to permit flash fusing the toner without appreciable heating of background areas by selecting a specific wavelength of exposure. Fusing of scattered toner particles (e.g., fog) was avoided by this process.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the toner of the JP reference in an imaging process that includes a flash fusing step because the JP reference seeks to form toner images with its toner by an electrostatic process and the supporting art shows that electrostatic processes are well known in the art for the formation of images. Further the primary reference is specifically concerned with avoiding toner scattering and Schaffert teaches that flash fusing is known in the art to avoid fusing of scattered toner particles to paper. The references are clearly concerned with similar issues, which motivate the combination of flash fusing in an imaging process with the toner of the JP reference.

The reference also does not disclose collection of a sublimate from the toner during fusing, but the instant specification teaches the sublimate collection by a filter is conventional during flash fusing processes (spec. p. 3, l. 15-27). This specification disclosure is seen as a discussion of the prior art. It would have been obvious for the artisan to collect the sublimate from the applied prior art's toner during flash fusing because this is taught by the specification as a conventional.



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Claims 9, 13, 18, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-198068 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162, and further in view of *Electrophotography* to Schaffert, pp. 55-57.

This Japanese document, as seen in the Abstract, discloses a color toner a colorant a vinyl resin. The toner has less than 10 weight percent of THF soluble components with a molecular weight less than or equal to 1000. Carrier 4 in the table on page 26 discloses a carrier for use with the toner having a size of 30.0  $\mu\text{m}$ . The inventive two-component developer seeks to reduce fog in its imaging process. The JP reference does not disclose using the developer in a flash fusing imaging process.

Diamond and Schaffert are relied upon for their disclosures as described in the rejection above. Specifically the references teach the use of flash fusing in electrostatic imaging processes and the advantages of this fusing technique.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the toner of the JP reference in an imaging process that includes a flash fusing step because the JP reference seeks to form toner images with its toner by an electrostatic process and the supporting art shows that electrostatic processes are well known in the art for the formation of images. Further the primary reference is specifically concerned with avoiding fog and Schaffert teaches that flash fusing is known in the art to avoid fusing of scattered toner particles to paper. The references are concerned with similar issues, which motivate the combination of flash fusing in an imaging process with the toner of the JP reference. The artisan would have found it obvious to minimize the amount of the component having a molecular weight at or below 1000 because the reference teaches that the amount should be at or below 10 weight percent. This would have suggested to the artisan that the

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amount of the component should be minimized at all molecular weights throughout the disclosed molecular weight range (see instant claim 13).

The reference also does not disclose collection of a sublimate from the toner during fusing, but the instant specification teaches the sublimate collection by a filter is conventional during flash fusing processes (spec. p. 3, l. 15-27). This specification disclosure is seen as a discussion of the prior art. It would have been obvious for the artisan to collect the sublimate from the applied prior art's toner during flash fusing because this is taught by the specification as a conventional.

Claims 9, 13, 18, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 901 046 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162, and further in view of *Electrophotography* to Schaffert, pp. 55-57.

As discussed above, this EP document exemplifies a toner comprising a binder resin and a carbon black colorant in Example 1 (pp. 27-28). The toner is mixed with 50  $\mu\text{m}$  diameter toner to form a two-component developer. Analysis of the toner shows a THF soluble component from the resin having molecular weights of 1000 or less in an amount of 1.0% based on the weight of the toner. Note the other toners having low levels of components with a molecular weight of 1000 or less in Tables 1, 8 and 15 (pp. 30, 41, 56, and 57). The EP reference does not disclose using the developer in a flash fusing imaging process, but does disclose heat fixing of the toner images (p. 2, l. 10).

Diamond and Schaffert are relied upon for their disclosures as described in the rejection above. Specifically the references teach the use of flash fusing in electrostatic imaging processes and the advantages of this fusing technique.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the toner of the EP reference in an imaging process that includes a flash fusing step because the EP reference seeks to form toner images with its toner by an electrostatic process and the supporting art shows that electrostatic processes are well known in the art for the formation of images.

The reference also does not disclose collection of a sublimate from the toner during fusing, but the instant specification teaches the sublimate collection by a filter is conventional during flash fusing processes (spec. p. 3, l. 15-27). This specification disclosure is seen as a discussion of the prior art. It would have been obvious for the artisan to collect the sublimate from the applied prior art's toner during flash fusing because this is taught by the specification as a conventional.

Claims 9, 13-15, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno *et al.* in US Patent 5,840,459 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162, and further in view of *Electrophotography* to Schaffert, pp. 55-57.

Ohno discloses a toner containing a polyester binder resin and a colorant as seen in Examples 4-6, which produce toners IV-VI (see Tables 2 and 3, cols. 37-38). The polyesters contain between 6.2 and 6.5 % of a resin component having a molecular weight of less than 1000. The polyester resin is produced from a ethylene and/or propylene oxide bisphenol A adduct given by the formula (1) (col. 12, l. 47-67; col. 34, l. 18-35). The reference discloses the value of x and y in the formula (1) as being at least 1; the value "f" being disclosed with sufficient specificity as to place the value within the artisan's possession. Additionally, terephthalic acid is used as a polyester reactant in Example 2 along with the bisphenol adducts as the only alcohol

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reactants. Also note Toners I-III which disclose resins other than polyesters having 5.2 to 6.6 % of resin component below 1000 molecular weight.

The reference does not specify the percentage of components having a molecular weight of 500 or less, but the reference does disclose that for the entire range of components having a molecular weight of 1000 or less, the amount is very small: 5.2 to 6.6 %. Given the small amount of components over the molecular weight range up to 1000 and the use of higher molecular weight components to produce the polyester (e.g., the bisphenol adducts), it is reasonable to expect that less than 4 parts of the toner would be components having a molecular weight below 500.

Image formation is disclosed for the toner with a heated fixing device (col. 38, l. 8-64). Ohno does not disclose using the developer in a flash fusing imaging process, but does disclose heat fixing of the toner images.

Diamond and Schaffert are relied upon for their disclosures as described in the rejection above. Specifically the references teach the use of flash fusing in electrostatic imaging processes and the advantages of this fusing technique.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the toner of Ohno in an imaging process that includes a flash fusing step because the Ohno seeks to form toner images with its toner by an electrostatic process and the supporting art shows that electrostatic processes are well known in the art for the formation of images. Additionally, flash fusing permits the artisan to obtain a quick fusing with minimal fusing of scattered toner and eliminate offset concerns expressed by Ohno (col. 2, l. 5-15). An advantage is to be gained by the noted process using Ohno's toners.

The reference also does not disclose collection of a sublimate from the toner during fusing, but the instant specification teaches the sublimate collection by a filter is conventional

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during flash fusing processes (spec. p. 3, l. 15-27). This specification disclosure is seen as a discussion of the prior art. It would have been obvious for the artisan to collect the sublimate from the applied prior art's toner during flash fusing because this is taught by the specification as a conventional.

Claims 9, 13, 18, 19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ayaki *et al.* in US Patent 5,985,502 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162, and further in view of *Electrophotography* to Schaffert, pp. 5557.

Ayaki discloses a toner having a binder resin and a colorant. The toner is treated with methanol to obtain a THF-soluble component having 0.5 % by weight of a component with molecular weight between 200 and 1000 (col. 14). The toner is combined with a 35 $\mu$ m diameter carrier. Note the other Examples are they are similarly applicable to the claims and Table 1. Ayaki is specifically concerned with toner scattering (col. 6, l. 3).

Ayaski does not disclose using the developer in a flash fusing imaging process, but does disclose heat fixing of the toner images.

Diamond and Schaffert are relied upon for their disclosures as described in the rejection above. Specifically the references teach the use of flash fusing in electrostatic imaging processes and the advantages of this fusing technique.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the toner of Ayaki in an imaging process that includes a flash fusing step because the Ayaki seeks to form toner images with its toner by an electrostatic process and the supporting art shows that electrostatic processes are well known in the art for the formation of images. Additionally, flash fusing permits the artisan to obtain a quick fusing with minimal fusing of scattered toner. As the references have common concerns (i.e., toner

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scattering) the artisan would expect an advantage by a flash fusing process using Ayak's toners.

The reference also does not disclose collection of a sublimate from the toner during fusing, but the instant specification teaches the sublimate collection by a filter is conventional during flash fusing processes (spec. p. 3, l. 15-27). This specification disclosure is seen as a discussion of the prior art. It would have been obvious for the artisan to collect the sublimate from the applied prior art's toner during flash fusing because this is taught by the specification as a conventional.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7-244400 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162, and further in view of *Electrophotography* to Schaffert, pp. 55-57 as applied to claims 9, 13, and 19 above, and still further in view of Inaba *et al.* in US Patent 5,741,617.

The JP reference, Diamond, and Schaffert were described above. The JP reference is specifically concerned with providing excellent fixing characteristics and an excellent color image while reducing fog and scattering. The reference, as seen in the Abstract, does not disclose the wax of the instant claim.

Inaba discloses a wax composition containing ester waxes such as Ester Compound No. 4 (col. 8) as a toner additive. This wax falls within the scope of the wax general formula A in column 6. The wax composition aids in producing low-temperature fixing, anti-offset properties, and good transparency for color images (col. 4, l. 29-41). The wax composition is used in an amount of from 1 to 40 parts by weight, preferably 2 to 30 parts by weight (col. 10, l. 39-55). Example 1 produces a toner having 60 parts by weight of a wax based on 286 total parts of components. This wax has 74 wt. % of the ester wax component.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the exemplified ester wax of Inaba in the invention of the JP reference because the JP reference desires components that will give excellent fixing and excellent color images. These features are provided by the wax composition of Inaba. The artisan would have been expected to optimize the amount of ester wax in the toner based on the guidance provided in the reference to obtain the results discussed.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 7-244400 in view of *Handbook of Imaging Materials* to Diamond, pp. 160-162, and further in view of *Electrophotography* to Schaffert, pp. 55-57, as applied to claims 9, 13, and 19 above, and still further in view of Fukuzawa *et al.* in US Patent 6,052,940.

The JP reference, Diamond, and Schaffert were described above. The JP reference is specifically concerned with providing excellent fixing characteristics and an excellent color image while reducing fog and scattering. The reference, as seen in the Abstract, does not disclose the wax of the instant claim.

Fukuzawa discloses a polyolefin wax having a number average molecular weight of from 1000 to 15000 and a weight-average molecular weight of from 1000 to 30,000 (col. 2, l. 7-18) as a toner additive. Propylene homopolymers are specifically disclosed as useful polyolefin waxes (col. 3, l. 3-8). The wax aids in producing excellent fixing, anti-offset properties, anti-spent toner properties and sharp, high quality images (Abstract; col. 1, l. 26-63).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the exemplified ester wax of Fukuzawa in the invention of the JP reference because the JP reference desires components that will give excellent fixing properties. These features are provided by Fukuzawa's wax.

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**Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

✓ Claims 9, 11, and 12 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9, 11, and 12 of copending Application No. 09/617748. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

✓ Claims 13-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 3-6, 9, and 13-16 of



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copending Application No. 09/617748. Although the conflicting claims are not identical, they are not patentably distinct from each other because the artisan would have found it obvious to use the toner of the copending claims in the process of the copending claims. The claimed toner falls within the scope of the toner in the process thus suggesting that the materials are usable together

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited art is directed to polyester-containing toners used in flash fusing processes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

cdr  
April 30, 2002

  
CHRISTOPHER RODEE  
PRIMARY EXAMINER